

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Timothy Heaton
Application No. : 10/661,763 Confirmation No. : 8158
Filed : September 11, 2003
For : GRAPHICAL USER INTERFACE RELATED TO NON-
STANDARD TRADING OF FINANCIAL
INSTRUMENTS
Group Art Unit : 3691
Examiner : Bijendra K. Shrestha

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection of October 29, 2008 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS**I. THE EXAMINER FAILS TO ESTABLISH A PRIMA FACIE CASE OF ANTICIPATION OF CLAIMS 1-5 AND 8**

The Examiner rejects claims **1-5** and **8** under 35 U.S.C. § 102(b) as being anticipated by Finkelstein et al., U.S. Patent Application Publication No. 2001/0037284 (hereinafter Finkelstein). Office Action, paragraphs 1-8, pages 2-5. The Examiner's failure to establish a *prima facie* case of anticipation of any of claims **1-5** and **8** results in clear error.

a. The Examiner fails to show that Finkelstein discloses each and every element of at least claim 1

MPEP § 2131 sets forth an Examiner's duties under § 102:

A claim is anticipated only if **each and every element as set forth in the claim** is found, either expressly or inherently described, in a single prior art reference.... The identical invention must be shown in **as complete detail as is contained in the ... claim**. (bold emphasis added).

In rejecting independent claim **1** regarding the limitations "*receiving from a Repurchase desk at least one price at which the financial instrument may be transacted at the specified settlement date,*" the Examiner asserts in part:

see Fig. 3; where dealer post settlement dates of Agency securities O/N (1), 1WK(7) and 2WK (14); **Examiner notes Repurchase Desk is intermediary between an investor and the dealer or seller.** Office Action, paragraph 3, page 3 (bold emphasis added).

No where in Figure 3 does Finkelstein make any reference that a "Repurchase Desk is [an] intermediary between an investor and the dealer or seller." Rather, the Examiner's rejection of claim **1** is based on purely conclusory assertions. However, conclusory assertions are insufficient to establish a *prima facie* case of anticipation in that a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Because the Examiner fails to show that Finkelstein discloses each and every element of claim **1**, the Examiner fails to establish a *prima facie* case of anticipation of this claim, and the claims that depend there from.

b. The Examiner fails to show that Finkelstein discloses each and every element of claim 4

In rejecting dependent claim **4**, the Examiner asserts:

see Fig. 3; where rate (price) for different contract to be settled is displayed; **Examiner notes cash settled contract can be displayed accordingly.** Office Action, paragraph 6, page 4 (bold emphasis added).

The Examiner's rejection of claim **4** is based on the conclusory assertion that a "cash settled contract can be displayed accordingly." Again, conclusory assertions are insufficient to establish a *prima facie* case of anticipation. Because the Examiner fails to show that Finkelstein discloses each and every element of claim **4**, the Examiner fails to establish a *prima facie* case of anticipation of this claim.

II. THE EXAMINER FAILS TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS OF CLAIMS 9-11, 13, AND 16-25

The Examiner rejects claims **9-11, 13, and 16-25** under U.S.C. § 103(a) as being unpatentable over Finkelstein in view of Dwin, U.S. Patent Application Publication No. 2004/0030638 (hereinafter Dwin). Office Action, paragraphs 9-22, pages 5-11. The Examiner's failure to establish a *prima facie* case of obviousness of any of claims **9-11, 13, and 16-25** results in clear error.

a. The Examiner fails to provide any evidence of record to support the Examiner's purported motivation for combining the references in the manner recited by at least claims 9, 16, 19, and 24

In a determination of obviousness, the Examiner must support all factual findings with substantial evidence of record. In re Zurko, 258 F.3d 1379, 1383-84 and 86 (Fed. Cir. 2001). The Supreme Court has reiterated that mere conclusory statements are insufficient on which to base a conclusion of obviousness. KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-42 (S.Ct. 2007). Even the MPEP clearly articulates that an obviousness rejection must be based on factual findings supported by substantial evidence of record. See MPEP §§ 2141(II) and 2144.03.

In rejecting independent claim **9**, and similarly dependent claims **16, 19, and 24**, the Examiner asserts that it would be obvious:

- to combine alleged features of Dwin Figures 1-4 and paragraphs [0030] and [0032] with alleged features of Finkelstein in the manner recited by claim **9**,

- to combine alleged features of Dwin Figure 4 and paragraphs [0053] and [0055] with alleged features of Finkelstein in the manner recited by claim **16**, and
- to combine alleged features of Dwin Figure 4 and paragraphs [0053-0055] with alleged features of Finkelstein in the manner recited by claims **19** and **24**.

In each of these cases, the Examiner makes the same assertion, that it would be obvious to combine alleged features of Dwin with Finkelstein “because Dwin teaches including above features would enable to provide efficient form of financing by improving returns on capital and returns on equity (Dwin paragraph [0004]).” Office Action, paragraphs 11, 15, and 18, pages 6-10.

Notably, the portion of Dwin paragraph [0004] referred to by the Examiner in support of this purported motivation reads in full as:

These repurchase agreements provide an efficient form of financing for investors interested in improving returns on capital and returns on equity.

In other words, the portion of Dwin paragraph [0004] referred to by the Examiner is not directed at the alleged features of Dwin Figures 1-4, or paragraphs [0030], [0032], and [0053-0055]. Accordingly, contrary to the Examiner’s assertions, the portion of Dwin paragraph [0004] referred to by the Examiner does **not teach** that combining Finkelstein with alleged features of Dwin Figures 1-4, and paragraphs [0030], [0032], and [0053-0055] “would enable to provide efficient form of financing by improving returns on capital and returns on equity.”

On the contrary, the Examiner’s purported motivation for combining the references is purely conclusory, unsupported by the Examiner with any evidence of record. As articulated by the MPEP, and by the Supreme Court and the Federal Circuit, examiner statements unsupported by any evidence of record are insufficient to establish a *prima facie* case of obviousness.

Accordingly, the Examiner fails to establish a *prima facie* case of obviousness of claims **9, 16, 19, and 24**, and the claims that depend there from.

b. The Examiner fails to show that the references disclose all limitations of claims 20 and 25

To establish a *prima facie* case of obviousness of a claimed invention, the Examiner must show that all limitations of a claim are taught or suggested by the prior art. Further, the MPEP reads in part:

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. **35 U.S.C. 132 requires that the applicant be notified of**

the reasons for the rejection of the claim so that he or she can decide how best to proceed. MPEP § 2141(II) (emphasis added).

In rejecting dependent claims **20** and **25**, the Examiner asserts:

Finkelstein et al. further teach the method repurchase agreement as described in claim 19 above. Dwin further teaches reverse repurchase agreement between repo desk, lender and shirt seller as shown Fig. 4 and paragraphs [0010] and [0050]. Office Action, paragraph 19, page 10.

First, Dwin Fig. 4 and paragraphs [0010] and [0050] do not disclose the limitations of claims **20** and **25** and as such, the Examiner fails to establish a *prima facie* case of obviousness of these claims.

Second, assuming, *arguendo*, that the Examiner is rejecting claims **20** and **25** based on the rejection of claim **19** in view of Dwin Fig. 4 and paragraphs [0010] and [0050], the Examiner fails to articulate, and Applicant is unable to ascertain, the connection between the rejection of claim **19** and the cited portions of Dwin. Accordingly, Applicant is unable to respond to the rejection of at least claims **20** and **25** because the Examiner fails to notify Applicant of the Examiner's basis for the rejection. As important, Applicant is not required to guess at the Examiner's position.

III. CONCLUSION

The Examiner's failure to establish a *prima facie* case of anticipation or obviousness of the claims results in clear error. Withdrawal of the rejection is respectfully requested.

Respectfully submitted,

April 29, 2009
Date

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